

REMARKS

The present amendment is in response to the Office Action dated July 26, 2004. Claims 1-39 are now present in this case. Claim 22 has been amended to add the word "and" between the final two paragraphs of the claim.

The applicants wish to express their appreciation to the Examiner for a telephone interview with the applicants' attorney on October 5, 2004. As discussed in that telephone conference, rejection of the claims under 35 U.S.C. § 112, first paragraph and second paragraph were based on confusion in interpreting the claim language with respect to the specification and the inability of the Examiner to put claim limitations "together in a diagram to configure illustrated figures/invention in the disclosure." Claims 1 and 21 have been amended to more clearly recite the invention. It should be noted that claim 11 has been amended only to break up large paragraph into smaller paragraphs to assist the Examiner in interpreting the claims. This amendment does not affect the scope of the claim. Additionally, claim 22 has been amended only to add the word "and" before the last paragraph.

Figure 8A has been amended to add the reference numeral 62 to illustrate the "stat slot or aperture." This should not be considered new matter as the stat slot 62 is illustrated in Figures 1-3 and described in paragraph 33, paragraph 38, and paragraph 40 of the specification as originally filed. It should also be noted that the stat slot 62 is discussed in paragraph 60 (page 15) with respect to Figure 8A. However, Figure 8A inadvertently failed to include this reference number. The present amendment corrects this oversight. Formal drawings, containing Figures 8A and 8B are enclosed herewith. It should be noted that no changes were made to Figure 8B.

On page two of the Office Action, an entry entitled "Double Patenting" includes an objection to claims 28-29, 30-31, and 32-33. It is noted that these claims are not rejected under statutory double patenting or judicially imposed obviousness-type double patenting. Indeed, a double patenting rejection is entirely inappropriate.

It appears that claims 28-29, 30-31, and 32-33 are objected to under 37 C.F.R. § 1.75 as being "a substantial duplicate of claim set 1-2." While applicants do

not dispute the fact that substantially duplicate claims should not be permitted, even though there may be slight differences in wording, applicants respectfully request reconsideration of this objection. The following discussion will point out a number of the more significant differences in the claims that were indicated as being substantial duplicates.

As noted in M.P.E.P. § 706.03(k), Court decisions have confirmed an Applicants' right to restate (*i.e.*, by plural claiming) the invention in a reasonable number of ways. It is further stated that "indeed, a mere difference in scope between claims has been held to be enough." Thus, two claims are not duplicates if there is a "mere difference in scope" between the claims. As indicated in the dictionary, duplicate means either of two things that exactly resemble or correspond to each other. For example, one is a copy of the other. A duplicate is something that is identical to another thing. As noted in M.P.E.P. § 706.03(k), if two claims are identical except for slight difference in wording, they can be considered substantial duplicates. But, if there is even a "mere difference in scope" the claims are not duplicates and should not be objected to as being substantial duplicates. As will be discussed below, the claims objected to as being substantial duplicates are in fact different in scope and different by much more than slight differences in wording that do not affect their scope.

COMPARISON OF CLAIMS 1 AND 28

Claims 1 and 28 are not "substantial duplicates." Claim 1 includes a number of elements that are not recited in any fashion within claim 28. Claims 1 recites a game piece in which each type of indicia indicates information related to a different aspect of the play of the game and are expressed as game play values. Claim 28 does not recite that each type of indicia indicates information related to a different aspect of the play of the game. Clearly, claims 1 and 28 have a difference in scope in that a game piece having play indicia with each type of indicia indicating information related to a different aspect of the play of the game would literally infringe claim 1, but would not literally infringe claim 28.

Claim 1 further requires that the indicia of one type in at least some of the groupings having game play values different from the indicia of the same type in others of the groupings. Claim 28 contains no such recitation in any form. A game piece having such indicia would literally infringe claim 1, but would not literally infringe claim 28.

The difference is noted between claims 1 and 28 involve differences in scope and recited structural elements. These are not just slight differences in wording. Applicants are entitled to use plural claiming so long as the claims have different scope. Claims 1 and 28 clearly have different scope since a game piece may literally infringe one claim and not the other. Other differences exist between claims 1 and 28.

COMPARISON OF CLAIMS 1 AND 30

Claims 1 and 30 are not “substantial duplicates.” For example, claim 1 requires a game piece with game play indicia wherein each type of indicia indicates information related to a different aspect of the play of the game and being expressed as game play values. Claim 30 does not require each type of indicia indicating information related to a different aspect of the play of the game. Claim 30 recites information being arranged as indicia have in a plurality of game play values. As such, a game piece having a plurality of game play values, but which does not have each type of indicia indicating information related to a different aspect of the play of the game would literally infringe claim 30, but would not literally infringe claim 1. This is a difference in claim scope preventing the claims from being considered duplicates.

As noted above, claim 1 recites the indicia of one type in at least some of the groupings having game play values different from the indicia of the same type in others of the groupings. Claim 30 contains no such recitation. Such differences create a substantial difference in scope between the claims. For all these reasons, claims 1 and 30 cannot be said to be duplicates. Other differences between the claims also exist.

COMPARISON OF CLAIMS 1 AND 32

Claims 1 and 32 are not “substantial duplicates.” For example, claim 1 is directed to a self-contained record-keeping device wherein the record-keeping device adjustably displays variable information relating to the game. Claim 32 recites a record-keeping device that displays information relating to the performance characteristics of the game piece in the game. This is a difference in scope between the claims.

In addition, claim 1 recites that information is arranged in a plurality of selectable groupings of game play indicia with each grouping having a plurality of different types of game play indicia. Claim 32 contains no such recitation. This is another difference in scope between the claims.

Furthermore, claim 1 requires that each type of indicia indicates information related to a different aspect of the play of the game and expressed as game play values. Claim 32 contains no such recitation.

Finally, claim 1 requires that the indicia of one type in at least some of the groupings has game play values that are different from the indicia from the same type in others of the groupings. Again, claim 32 contains no such recitation. This is another difference in scope between the claims. A game piece may literally infringe one claim and not the other. For all these reasons, claims 1 and 32 cannot be said to be duplicates. Other differences between the claims exist.

OTHER CLAIMS

The Office Action further states that dependent claims 29, 31, and 33 are alleged to be duplicates of claim 2. Since claim 2 depends from claim 1, and the dependent claims alleged to be duplicate depend from one of the other independent claims discussed above, for the same reasons discussed above with respect to the independent claims, there are more than slight differences in wording between the dependent claims. Rather, the claims are different in scope and cannot be said to be duplicates. For brevity, all those differences between the dependent claims will not be discussed.

NON-ART REJECTIONS

Claims 1-39 stand rejected under 35 U.S.C. § 112, first paragraph because the best mode contemplated by the inventor has not been disclosed. Claims 1-39 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1-39 are further rejected under 35 U.S.C. § 112, second paragraph as being incomplete. As noted above, these rejections were based on the Examiner's confusion in interpreting the claims and the apparent lack of ability to place claim limitations "together in a diagram to configure illustrated figures/invention in a disclosure." (See page 3, paragraph 4 and paragraph 6.) Following the telephone interview with the Examiner on October 5, 2004, there is now a more complete understanding of the claims in relationship to the detailed description. In addition, certain claims have been amended to more clearly recite the nature of the invention. Accordingly, the applicants kindly request that the Examiner withdraw all rejections based on 35 U.S.C. § 112.

PRIOR ART REJECTIONS

The Applicants wish to express their appreciation to the examiner for indicating that claims 4 and 17 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and amended to be an independent form. However, as will be discussed in detail below, claims 4 and 17 are believed allowable in their present form.

Claims 1-3, 5-12, and 28-33 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 62704102 DeMar et al. The applicants respectfully disagree with the assessment of DeMar and its applicability to the claimed invention. *DeMar* is directed to a remote control slot machine, which is fundamentally different from a game piece for use in a game, as recited in claim 1. The Office Action states that DeMar teaches a self-contained record-keeping device. This is incorrect. There is no record-keeping of any sort that occurs in the device of DeMar. A slot machine consists of a series of rotating reels, which the Office Action equates to game play indicia. However, DeMar clearly states that game operation is initiated by manually pulling a lever forward to rotate the reels. "If the reels displayed identical symbols, such

as cherries, oranges, etcetera, the game would be won and the one-armed bandit would dispense one or more coins in accordance with established odds and the rules of the game.” (See Column 1, lines 28-33). Thus, each pull of the lever constitutes a complete game. There is no record-keeping of any sort involved in DeMar. The value indicated on the reels at the end of one game has no effect on the next game. Each game is totally independent and there is no need for a record-keeping device. In contrast, claim 1 recites “a self-contained record-keeping device for placement on the game playing surface.” DeMar does not teach or suggest such a device and is not a “game piece” and is not used on a “game playing surface.” DeMar has no need for record keeping.

In addition, the record-keeping device of claim 1 displays variable information related to the game and arranged in a plurality of selectable groupings of game play indicia and recites, *inter alia*, “each type of indicia indicating information related to a different aspect of the play of the game and being expressed as game play values.” The so-called game play indicia of DeMar (*i.e.*, the rotating reels) are not related to a different aspect of the play of the game. In the example illustrated in figures 1-3 of DeMar, three reels are set into spinning motion by activation of the game. The three reels do not relate to different aspects of the play of the game. It is merely the combination of the final result of the three reels, when they stop, that provides the results of the completed game. DeMar does not teach or suggest a self-contained record-keeping device wherein each type of indicia indicates information related to a different aspect of the plan of the game.

Claim 1 recites the information relating to the game is “arranged in a plurality of selectable groupings of game play indicia.” DeMar does not teach or suggest any such feature. The so-called indicia of DeMar (*i.e.*, the rotating reels) rotate independently of one another and are thus not arranged in a plurality of selectable groupings. Indeed, the ability to select groupings in a system, such as DeMar, would amount to cheating in operation of the slot machine. No such cheating is intended by DeMar. There is no suggestion of information being arranged in selectable groupings, as recited in claim 1.

Finally, the self-contained record-keeping device recites “a slot for placement of an indicia altering token therein.” The Office Action equates a coin slot in the slot machine of DeMar is disclosing the slot for placement of indicia-altering token recited in claim 1. This is incorrect. The device of claim 1 uses information arranged in a plurality of selectable groupings of game play indicia. The so-called game indicia in DeMar (*i.e.*, the rotating reels) are not altered by placing another coin in a slot. Placing money in a slot of a slot machine does not alter the value shown on the reels. Displaying credit on a screen display is not information related to the game. Furthermore, credit information is not arranged in a plurality of selectable groupings, as recited in claim 1. Accordingly, claim 1 is clearly allowable over DeMar. Claims 2-10 are also allowable in view of the fact that they depend from claim 1, further in view the recitation of each of those claims.

Claim 11 is directed to a game piece for use in a game and recites “a self-contained record-keeping device.” As noted above with respect to claim 1, DeMar is a slot machine game and does not teach or suggest any record-keeping nature. As noted in DeMar, a game is initiated when a lever is activated to begin rotating the reels, and the game ends when the reels stop rotating. There is absolutely no record-keeping aspect to these so-called indicia. Using, by way of example, the game piece illustrated in figure 8A, the record-keeping device displays variable information within a stat slot 62 that relate to the game. DeMar has no need for such record-keeping since the game ends when the rotating reels stop. Thus, DeMar actually teaches away from a record-keeping device.

Claim 11 further recites, *inter alia*, that “the record-keeping device adjustably displays variable information relating to the game, the information being arranged in a plurality of selectable groupings of game play indicia.” As noted above, DeMar has no selectable groupings of game play indicia. The so-called indicia (*i.e.*, the rotating reels) are not arranged in selectable groupings. As noted above, such selectable groupings would amount to cheating, which is not contemplated in the device of DeMar. The multiple rotating reels operate independently of each other and are not arranged in a plurality of selectable groupings, as recited in claim 11.

Claim 11 further recites that “each type of indicia indicating information related to a different aspect of the play of the game and being expressed as game play values.” DeMar does not teach or suggest such a structural arrangement. The so-called game indicia (*i.e.*, the rotating reels) in DeMar are not related to different aspects of the play of the game. The three reels rotate independently, and when stopped, indicate the final outcome of the game. There are no “different aspects” to be indicated by the so-called indicia in DeMar.

Finally, claim 11 recites the record-keeping device including “a receiver portion to receive and removably retain an indicia-altering token therein.” The Office Action equates a coin slot as equivalent to the receiver portion recited in claim 11. This is not correct. The device of claim 1 uses information arranged in a plurality of selectable groupings of game play indicia. The so-called game indicia in DeMar (*i.e.*, the rotating reels) are not altered by placing another coin in a slot. Indeed, there is no structural relationship or functional relationship between placing a bet and activating the spinning reels. Placing money in a slot of a slot machine does not alter the spinning reels. Displaying credit on a screen display is not information related to the game. Furthermore, credit information is not arranged in a plurality of selectable groupings, as recited in claim 1. Accordingly, claim 1 is clearly allowable over DeMar. Claim 12 is also allowable in view of the fact that it depends from claim 1, and further in view the recitation within the claim.

Claim 28 is directed to a game piece for use in a game and recites, *inter alia*, “a self-contained record-keeping device that displays variable information relating to the performance characteristics of the game piece in the game.” As previously discussed, DeMar has absolutely no record-keeping elements at all. The game is complete when the spinning reels stop. There is no teaching in DeMar for record-keeping and, indeed, no need for record-keeping since the game is completed upon stopping the rotating reels. Furthermore, the record-keeping device in claim 28 displays variable information relating to the “performance characteristics of the game piece in the game.” A slot machine has no performance characteristics whatsoever. The rotating reels may be considered somewhat the equivalent of rolling dice used in the game play

(see page 41, paragraph 115). However, there are no performance characteristics involved in a slot machine game and thus, no reason to display variable information relating to performance characteristics.

Claim 28 further recites that the information is “arranged in a plurality of groupings of game play indicia and being expressed as game play values.” The so-called indicia in DeMar (*i.e.*, the rotating reels) rotate independently and are not arranged in any plurality of groupings. As noted above, any arrangement in groupings would amount to cheating in the slot machine game.

Finally, claim 28 recites “a receiver portion to receive and removably retain an indicia altering token therein.” The Office Action has equated a coin slot in a slot machine as equivalent to the receiver portion recited in claim 28. This is not correct. The indicia recited in claim 28 indicate performance characteristics of the game piece in the game. The amount of credit available to the player of a slot machine is unrelated to performance characteristics of the game piece, such as recited in claim 28. The amount of credit available to the slot machine user is unrelated to the performance characteristics and is not arranged in a plurality of groupings. Indeed, the operation of the rotating reels in DeMar is independent of the gambling aspect of the slot machine. The indicia-altering token in claim 28 affects the performance characteristics of the game piece having more or less credit by placing coins in the slot of the slot machine do not affect the performance characteristics. Accordingly, claim 28 is clearly allowable over DeMar. Claim 29 is allowable in view of the fact that it depends from 28, and further in view of the recitation within that claim.

Claim 30 is directed to a game piece for use in a game and comprises “a self-contained record-keeping device.” As noted above, DeMar does not teach or suggest and has no need for record-keeping because the game ends when the reels stop rotating. Furthermore, the record-keeping device displays variable information “relating to the performance characteristics of the game piece in the game.” A slot machine is not a game piece; it is an entire game unto itself. A slot machine has no performance characteristics. The rotating reels do not display information relating to performance characteristics. The spinning reels of DeMar only provide the results of

the game play. DeMar does not teach or suggest any need to display information relating to performance characteristics.

Claim 30 also recites “a receiver portion to receive and removably retain an indicia altering token therein.” As discussed above, a coin slot in the slot machine of DeMar is not the equivalent of a receiver portion. The credit value on a screen display is unrelated to any performance characteristics, such as recited in the record-keeping device of claim 30. DeMar has no need for altering indicia related to performance characteristics. Accordingly, claim 30 is clearly allowable over *DeMar*. Claim 31 is also allowable in view of the fact that it depends from claim 30, and further within the recitation within the claim.

Claim 32 is directed to a game piece for use in a game and recites, *inter alia* “a self-contained record-keeping device.” As noted above, there is no record-keeping functionality taught or suggested by DeMar. The slot machine game begins when the lever is pulled and ends when the rotating reels stop. DeMar has no need for a record-keeping device.

The record-keeping device of claim 32 “displays information relating to the performance characteristics of the game piece in the game.” Examples of performance characteristics have been described above. The rotating reels in DeMar are unrelated to any performance characteristics.

Finally, claim 32 recites “a receive portion to receive and removably retain a performance characteristic altering token therein.” As noted above, coin slot in a slot machine of DeMar is not equivalent portion recited in the present claims. In claim 32, the receive portion can receive and removably retain a performance characteristic-token. Changes in credit value are unrelated to performance characteristics of the game piece. Accordingly, claim 32 is clearly over DeMar. Claim 33 is also allowable in view of the fact that it depends from claim 32, and further in view of the recitation within the claim.

Claims 21-27 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6182967 to Green. The Applicants respectfully disagree with the assessment of Green and its applicability to the claimed invention. In one sentence, the

Office Action summarizes Green as teaching game pieces with slots for receiving value-altering tokens that all the game piece to be played in an interactive game according to rules of engagement. Such a broad statement ignores the recitation of claim 21 that are not taught or suggested by Green. Green describes a game piece in which prongs may be added to indicate allowable directions of movement of the game piece on a board. However, interaction between the game pieces is accomplished by "jumping" the game piece similar to a manner similar to that in checkers. (See column 3, lines 62-65.)

In sharp contrast, the outcome of an interaction with the method recited in claim 21 is based on "game play values being selected to produce outcomes of the simulated interactions between the first and second game pieces according to the set of game rules by comparison of a number determined based on the game play values of the game play indicia in one grouping of the first game piece with a number determined based upon the game play values of the game play indicia in one grouping of the second game piece." The game play values are indicated by game play indicia on the self-contained record keeping device. Green does not teach or suggest any game play values or comparison of numbers based on game play values to determine an outcome of interaction between game pieces. Accordingly, claim 21 is clearly allowable over Green.

Claim 22 is a method claim in which first and second game pieces each include "a self-contained record-keeping device having a plurality of alterable game values indicative of the operational characteristics of the first and second game pieces." The method of claim 22 also requires "a receiver portion in the first game piece to receive and removably retain a token to thereby alter a select game value." A token is placed in the receiver portion to alter the selected game play value of the first game piece and interaction between the first and second game pieces comprises "comparing the altered game play value of the first game piece with the game play value of the second game piece, and based on the comparison determining an outcome of the initial simulated interaction between the first and second game pieces according to the set of game rules." Green describes no technique for altering a game play value nor a process of comparing an altered game play value of a first piece with the game play

value of the second piece to determine an outcome. The interaction between game pieces in Green is determined by one piece “jumping” over the other piece. Green does not teach or suggest any comparison of game play values. Accordingly, claim 22 is clearly allowable over Green. Claims 23-27 are also allowable in view of the fact that they depend from claim 22, and further in view of the recitation within each of those claims.

Claims 34-39 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4083564 to Matsumoto. The Applicants respectfully disagreement with the assessment of Matsumoto and its applicability to the claimed invention. Matsumoto describes a board game in which the individual game pieces have a variable movement indicator that is magnetically rotated when the game piece is moved. In the example provided in Matsumoto, a rotatable wheel indicates a number 1-4 that shows how many spaces that player may move in its next turn. It should be noted that interaction between the game pieces occurs when one game piece is moved into the space occupied by an opposing game piece. (See column 3, lines 60-62.) Thus the interaction of game pieces in *Matsumoto* is determined simply by the physical location of one game piece with respect to an opposing game piece.

In sharp contrast, claim 34 is a method claim involving first and second movable game pieces that each include a “self-contained, record-keeping device that displays information related to the performance characteristics of the first and second game pieces, respectively, in the game.” The method of claim 34 also recites “associating a performance characteristic altering indicator with the first game piece to alter a performance characteristic of the first game piece.” In a simulated interaction between game pieces, claim 34 recites “comparing the altered performance characteristic of the first game piece with a corresponding performance characteristic of the second piece and, based on the comparison, determining an outcome of the simulated interaction between the first and second game pieces according to the set of game rules.” Matsumoto does not teach or even suggest such a comparison process. The rotating distance wheel in Matsumoto relates to the distance in which a piece may move. However, the interaction of game pieces is based simply on the game piece

landing on a location occupied by the opponent's game piece. There is no comparison of characteristics of the opposing game pieces and determination of an outcome based on a comparison, such as recited in claim 34. Accordingly, claim 34 is clearly allowable over Matsumoto. Claims 35-39 are also allowable in view of the fact that they depend from claim 34, and further in view of the recitation in each of those claims.

Claims 13-16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of DeMar with U.S. Patent No. 5242163 to Fulton. The applicants respectfully disagree with this assessment and its applicability to the claimed invention. The inapplicability of DeMar has already been discussed with respect to other claims. However, DeMar, even when combined with Fulton, is equally irrelevant to claim 13.

Claim 13 recites first and second movable game pieces used in playing a game based on simulated interactions of the first and second game pieces. Each of the game pieces comprises "a first member having a plurality of discrete groupings of game play indicia, each grouping including a plurality of different types of game play indicia, each type of indicia indicating information related to a different aspect of play of the game and being expressed as game play values." It is unclear which aspect of either DeMar or Fulton is equivalent to a "first member" recited in claim 13. Neither DeMar nor Fulton contain any member having plurality of discrete groupings of game play indicia. Furthermore, neither the rotating reels in DeMar nor displayed video gaming values in Fulton describe discrete groupings of indicia or a "plurality of different types of game play indicia" with "each type of indicia indicating information related to a different aspect of play of the game" which are all required by claim 13.

As previously discussed, the rotating reels of DeMar are not directed to different aspects of the play of the game. It is the combination of final values when the reels stop rotating that indicate the outcome of the game in DeMar. Similarly, the bingo values or card game values in the system of Fulton are not directed to different aspects of play of the game. There is nothing in these references, taken alone or in combination, that suggests a first member having such structural characteristics as recited in claim 13.

The outcome of interaction between the first and second game pieces is determined “by comparison of a number determined based on the game play values of the game play indicia in one grouping of the first game piece with a number determined based upon game play values of the game play indicia in one grouping of the second game piece. Claim 13 recites *inter alia* “a second member having an indicator portion positioned to indicate one of the groupings for use of the indicia thereof to determine the number used for comparison, one of the first and second members being selectively manually movable relative to the other of the first and second members to selectively position the indicator portion to indicate one of the groupings.” The combination of DeMar and Fulton do not teach or suggest such a second member or the interaction between first and second members such as recited in claim 13. Neither of the references have first and second members that are selectively manually movable relative to the other to position an indicator. Indeed, there is no teaching of an indicator that selects one of the groupings of indicia. The so-called indicia (*i.e.*, the rotating reels) of DeMar are not selectable by manually moving a first and second member relative to one another. Similarly, Fulton completely lacks any such teaching.

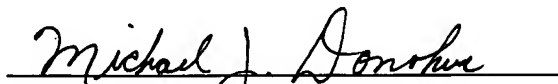
Finally, claim 13 recites a slot in at least one of the first and second game pieces for placement of an indicia-altering token therein. The coin slots in DeMar and Fulton do not teach or suggest the structural slot for placement of an indicia altering token. The indicia altered in claim 13 are selected by manual movement of the first and second members relative to each other. The combination of DeMar and Fulton do not have such members, do not select a grouping of indicia in such a manner, and do not have a slot for placement of indicia altering token. Accordingly, claim 13 is clearly allowable over the combination of DeMar and Fulton. Claims 14-20 are also allowable in view of the fact that they depend from claim 13, and further in view of the recitation in each of those claims.

In view of the above amendments and remarks, reconsideration of the application and its allowance are kindly requested. If questions remain regarding this application, the examiner is invited to contact the undersigned at (206) 628-7640.

Respectfully submitted,

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A handwritten signature in cursive script, reading "Michael J. Donohue", is written over a horizontal line.

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